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| 10/672,363 | 09/26/2003 | John William Miller | 06459 USA | 3026 |
| 23543 7590 05/15/2007 AIR PRODUCTS AND CHEMICALS, INC. PATENT DEPARTMENT 7201 HAMILTON BOULEVARD ALLENTOWN, PA 181951501 | | | EXAMINER COONEY, JOHN M | |
| | | | ART UNIT 1711 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/672,363
Filing Date: September 26, 2003
Appellant(s): MILLER, JOHN WILLIAM

**MAILED
MAY 15 2007
GROUP 1700**

Michael Leach
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1-12-07 appealing from the Office action mailed 6-27-06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

GROUND OF REJECTION NOT ON REVIEW

The following grounds of rejection have not been withdrawn by the examiner, but they are not under review on appeal because they have not been presented for review in the appellant's brief. Rejection of claims 1, 6-17 and 21-30 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,921,779.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|-----------|---------------|--------|
| 4,581,432 | BLUM ET AL. | 4-1986 |
| 6,086,788 | BOGDAN ET AL. | 7-2000 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 6-17 and 21-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blum et al.('432) in view of Bogdan et al.(6,086,788).

Blum et al. discloses preparations of polyurethane foams which can be prepared by combining polyisocyanate, polyol, ethylene glycol monobutyl ether, heat evaporative blowing agents, catalysts, and surfactants which read on the products and processes of appellants' claims (see abstract, column 13 lines 16-23, column 14 line 30, examples 5 & 6, and the claims, as well as, the entire document).

Blum et al. differs from appellants' claims in that it does not disclose employment of amounts of ethylene glycol monobutyl ether in amount values as claimed. However, Blum et al. does disclose variation in the amount of ethylene glycol monobutyl ether for

purposes of controlling dissolution of catalyst(see again Examples 3 and 5).

Accordingly, it would have been obvious for one having ordinary skill in the art to have controlled the amount of ethylene glycol monobutyl ether employed in the preparations of Blum et al. for the purpose of controlling catalyst dissolution effects in the preparations formed in order to arrive at the products and processes of appellants' claims with the expectation of success in the absence of a showing of new or unexpected results. It has long been held that where the general conditions of the claims are disclosed in the prior art, discovering the optimal or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233; *In re Reese* 129 USPQ 402 . Similarly, it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272,205 USPQ 215 (CCPA 1980).

Blum et al. differs from appellants' claims in that it does not particularly require the employment of the hydrohalocarbon blowing agents of appellants' claims. However, Blum et al. does teach employment of heat evaporative blowing agents within its teachings (see column 13 lines 16-28), and Bogdan et al. particularly discloses the employment of the hydrohalocarbon blowing agents of appellants' claims to be well known heat evaporative blowing agents employed in the polyurethane foam art for the purpose of providing foam forming effects (see column 1, as well as, the entire document). Accordingly, it would have been obvious for one having ordinary skill in the art to have employed the blowing agents of Bogdan et al. as the heat evaporable blowing agents in the preparations of Blum et al. for the purpose of imparting their

foaming effects in order to arrive at the products and processes of appellants' claims with the expectation of success in the absence of a showing of new or unexpected results.

(10) Response to Argument

Appellants' arguments have been considered. However, rejection is maintained. Examiner disagrees with appellants' contention that Blum et al.'s disclosure of the employment of ethylene glycol monobutyl ether to dissolve catalyst is not a recognized result effective variable. As set forth in the rejection, employment of ethylene glycol monobutyl ether for dissolution of catalyst is sufficient evidence that ethylene glycol monobutyl ether is a variable which achieves a recognized result of dissolving catalyst.

Blum et al. demonstrates control in the employment of the ethylene glycol monobutyl ether for dissolution of catalyst in that different amounts are used to dissolve the catalyst in the exemplary disclosures of examples 3 & 5 of their disclosure. It is readily evident that dissolution of catalyst is the effect imparted by the employment of ethylene glycol monobutyl ether in the disclosure of Blum et al., and it is readily apparent that more ethylene glycol monobutyl ether will better dissolve more catalyst and allow for dissolution of greater quantities of catalyst. Further, it can not be questioned that more of the same substance such as ethylene glycol monobutyl ether will dissolve more of another substance such as triethylenediamine. Examiner maintains dissolution of catalyst to be properly identified as the result-effective variable associated with the employment of ethylene glycol monobutyl ether in the disclosure of

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Blum et al., and, accordingly, examiner maintains that it has been properly held that discovering the optimum value of this result effective variable involves only routine skill in the art. Examiner agrees with appellants' assertion that the "result" that varying the level ethylene glycol monobutyl ether is taught to have an effect on is degree of dissolution, and modulation of its employment for the defined purpose of allowing for the dissolution of a little bit more catalyst is within the skill of the ordinary practitioner in the art having the teachings of the cited prior art before him.

Rejection is maintained to be proper, and appellants have not demonstrated unexpected results commensurate in scope with the scope of the claims that are associated with differences indicated in the rejection.

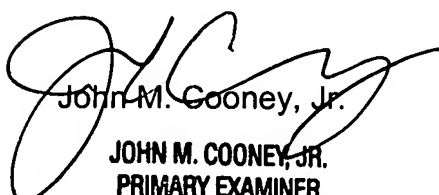
Appellants' arguments have been considered as to the secondary Bogdan et al. reference. However, this secondary teaching is looked to in order to remedy the deficiencies indicated in the rejection. Appellants' arguments do not rebut examiner's position in regards to this component of the rejection, and combination is maintained to be proper as set forth above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

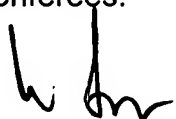
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

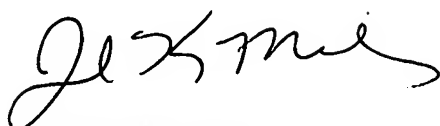

JOHN M. COONEY, JR.
PRIMARY EXAMINER
Group 1700

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Conferees:

A handwritten signature in black ink, appearing to read 'J Seidleck', with a stylized, cursive script.

James Seidleck

A handwritten signature in black ink, appearing to read 'J Michener', with a stylized, cursive script.

Jennifer Michener